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PATENTS  
CF-36

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mark Colaio  
Application No.: 10/015,739 Confirmation No.: 8873  
Filed : December 12, 2001  
For : METHOD AND SYSTEM FOR TRAINING TRADERS  
Group Art Unit : 2123  
Examiner : Not yet assigned

Mail Stop DAC  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

REQUEST FOR RECONSIDERATION OF  
PETITION UNDER 37 C.F.R. 1.47(b)

RECEIVED  
JUN 17 2003

Dear Sir:

OFFICE OF PETITIONS

Petitioner respectfully requests reconsideration of the Decision Refusing Status Under 37 C.F.R. 1.47(b) mailed November 12, 2002 in connection with the above-identified patent application. The Examiner contends that applicant's petition under 37 C.F.R. 1.47(b) lacks proof of proprietary interest and, accordingly, cannot be granted. Petitioner respectfully requests reconsideration of the Petition in light of the following remarks and enclosed legal memorandum.

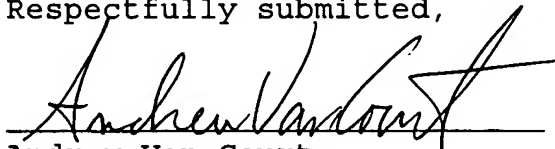
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REMARKS

As proof of proprietary interest in the subject matter of the present invention required to justify filing this application under 37 C.F.R. 1.47(b), Petitioner previously provided a portion of an unsigned employment agreement in an October 25, 2002 Request for Reconsideration of Petition Under 37 C.F.R. 1.47(b). The original executed agreement was lost or destroyed in the September 11, 2001 attack on the World Trade Center. The Examiner suggests that, because the executed copy of the agreement is no longer available, Petitioner should provide the requisite showing by filing a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would, by the weight of authority in that jurisdiction, award the title of the invention to the Rule 1.47(b) applicant. Petitioner files concurrently herewith the legal memorandum suggested by the Examiner.

Thank you for your prompt attention to this Request For Reconsideration.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrew Van Court", written over a horizontal line.

Andrew Van Court  
Registration No. 48,506  
Agent for Petitioner  
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Tel.: (212) 596-9000



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Application of Mark Colaio ) DECISION REFUSING  
United States Patent Application ) STATUS UNDER 37 C.F.R.  
No. 10/015,739 filed December 12, 2001 ) 1.47(b)  
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**PETITIONER'S LEGAL MEMORANDUM IN SUPPORT OF ITS  
PROPRIETARY INTEREST IN THE SUBJECT MATTER OF  
UNITED STATES PATENT APPLICATION NO. 10/015,739.**

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FISH & NEAVE  
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Attorney for Petitioner, Cantor Fitzgerald, LP

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## **INTRODUCTION**

Cantor Fitzgerald, L.P. ("Petitioner"), a corporation organized and existing under the laws of Delaware and having an office and place of business at 135 East 57<sup>th</sup> Street, 5<sup>th</sup> Floor, New York, New York 10022, files this legal memorandum in response to the Examiner's November 12, 2002 Decision Refusing Status Under 37 C.F.R. 1.47(b). This memorandum shows that, according to the applicable laws in the jurisdiction to which the issue pertains, Petitioner has provided sufficient proof of proprietary interest in the subject matter of U.S. Patent Application No. 10/015,739 to justify filing of the application under 37 C.F.R. 1.47(b).

## **STATEMENT OF FACTS**

Until the September 11, 2001 attack on the World Trade Center, Petitioner occupied an office and place of business at One World Trade Center, New York, New York. Mark Colaio, the deceased sole inventor of United States Patent Application No. 10/015,739, filed December 12, 2001, was employed by Petitioner at the time of the invention and until September 11, 2001. The invention was made in connection with Colaio's employment with Petitioner and, as a condition of his employment agreement with Petitioner, Colaio was obligated to assign the rights of the invention to Petitioner (as indicated in the unsigned copy of a portion of Colaio's employment agreement, attached hereto as Appendix I). The signed original copy of Colaio's employment agreement was kept at Petitioner's World Trade Center office until September 11, 2001. Colaio is missing and presumed dead, and his original employment agreement was lost or destroyed, as a result of the September 11, 2001 attack that destroyed the World Trade Center. Although the original employment agreement is unavailable, an unsigned copy of a portion of the original agreement (Appendix I) is available as secondary evidence to support Petitioner's proprietary interest in the subject matter of this patent application. A witness' declaration that the copy is a reliable and accurate portrayal of the signed original agreement, attached hereto as Appendix II, is also provided as secondary evidence to prove the existence and substance of the original agreement.

## ARGUMENT

Colaio's signed original employment agreement is not available to support Petitioner's proprietary interest in the subject matter of U.S. Patent Application No. 10/015,739. Nevertheless, for the reasons set forth in detail below, a court of competent jurisdiction in the State of New York would award the title of the application to Petitioner.

### A. SECONDARY EVIDENCE MAY PROVE THE CONTENTS OF AN UNAVAILABLE ORIGINAL LEGAL DOCUMENT

Under a long-recognized exception to the best evidence rule, both Federal and New York State Law allow for the introduction of secondary evidence to prove the contents of a legal document (e.g., an employment agreement) when the original has been lost or destroyed. See Schozer v. William Penn Life Ins. Co., 84 N.Y.2d 639, 644, (1994); Burroughs Wellcome Co. v. Commercial Union Ins. Co., 632 F.Supp. 1213, 1223 (S.D.N.Y.1986); see also Fed.R. of Evid. § 1004; Fisch, New York Evidence § 81, at 49 [2d ed]. In *Schozer*, the New York State Court of Appeals held that "secondary evidence of the contents of an unproduced original [document] may be admitted upon threshold factual findings by the trial court that the proponent of the substitute has sufficiently explained the unavailability of the primary evidence and has not procured its loss or destruction in bad faith." Schozer at 644; see also Fisch, New York Evidence § 81, at 49 and § 88-89, at 55-56 [2d ed]; Fed.R. of Evid. § 1004.

### B. PETITIONER CAN SUFFICIENTLY EXPLAIN WHY COLAIO'S SIGNED ORIGINAL EMPLOYMENT AGREEMENT IS UNAVAILABLE

Colaio's signed original employment agreement was lost or destroyed during the September 11, 2001 attack that destroyed the World Trade Center. Petitioner clearly did not lose or destroy the original document in bad faith. Accordingly, because Petitioner can sufficiently explain why Colaio's original agreement is not available, a New York State Court would be compelled to admit secondary evidence to prove the existence and substance of the original agreement.

C. SECONDARY EVIDENCE OF COLAIO'S SIGNED ORIGINAL  
EMPLOYMENT AGREEMENT IS AVAILABLE

As with any other lost original primary evidence, once the absence of the original is excused, "all competent secondary evidence is generally admissible to prove its contents" and "no categorical limitations are placed on the types of secondary evidence that are admissible." See Schozer at 645. The attached unsigned copy of a portion Colaio's original employment agreement is secondary evidence to prove the substance of the original agreement, and expressly states that "[Petitioner] shall have exclusive ownership of any and all right, title, and interest in...patents...associated with any...invention...produced during the course of your employment." The attached Declaration provides further evidence that the copy is a reliable and accurate portrayal of the original agreement. Accordingly, a New York State Court would, based on the terms of the original employment agreement, award the title of U.S. Patent Application No. 10/015,739 to Petitioner.

**CONCLUSION**

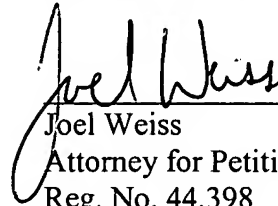
A court of the State of New York would affirm Petitioner's proprietary interest in the subject matter of U.S. Patent Application No. 10/015,739. The court's decision would be based on its consideration of secondary evidence proving the existence and substance of the original agreement between Colaio and Petitioner. Secondary evidence would be admissible in this case because Petitioner can provide a reasonable explanation as to why the original agreement is no longer available. The terms of the employment agreement clearly designate Petitioner as having exclusive ownership of U.S. Patent Application No. 10/015,739.

The foregoing demonstrates that Petitioner has provided sufficient proof of proprietary interest in the subject matter of U.S. Patent Application No. 10/015,739 to justify filing of the application under 37 C.F.R. 1.47(b).

Date: \_\_\_\_\_

6/10/03

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Joel Weiss", is written over a horizontal line.

Joel Weiss  
Attorney for Petitioner  
Reg. No. 44,398  
Fish & Neave  
1251 Avenue of the Americas  
New York, New York 10020  
(212) 596-9000



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DECLARATION OF HOWARD W. LUTNICK

OFFICE OF PETITIONS

Sir:

I, Howard W. Lutnick, hereby declare that:

1. I am Chairman and Chief Executive Officer of Cantor Fitzgerald, L.P. ("Cantor Fitzgerald") and its associated companies.

2. I reside at 180 East 64th Street, New York, New York.

3. Unless otherwise stated as being based on information and belief, the facts stated in this declaration are based on my personal knowledge.

4. Until the September 11, 2001 attack on the World Trade Center, Cantor Fitzgerald occupied an office and place of business at One World Trade Center, New York, New York.

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5. Mark Colaio, the deceased sole inventor of United States Patent Application No. 10/015,739, filed December 12, 2001, was employed by Cantor Fitzgerald at the time of the invention and until September 11, 2001. The invention was made in connection with Colaio's employment with Cantor Fitzgerald. As a condition of his employment, Colaio was obligated to assign the rights of all inventions made in connection with his employment to Cantor Fitzgerald. A signed original copy of Colaio's employment agreement was kept at Cantor Fitzgerald's World Trade Center office until September 11, 2001.

6. Mark Colaio is missing and presumed dead, and his original employment agreement was lost or destroyed, as a result of the September 11, 2001 attack that destroyed the World Trade Center. Because Cantor Fitzgerald's World Trade Center Office was completely destroyed during the attack, a diligent search for Colaio's original employment agreement was not reasonable or possible.

7. I have reviewed the accompanying unsigned copy of a portion of Colaio's original employment agreement. The copy is a reliable and accurate portrayal of the original agreement.

8. I declare, further, that I understand the English language and that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and, further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that

6/10/2003



Howard W. Lutnick

**APPENDIX I:**  
**UNSIGNED COPY OF A PORTION OF COLAIO'S EMPLOYMENT AGREEMENT**

**CANTOR FITZGERALD EMPLOYMENT AGREEMENT**

Cantor Fitzgerald owns all the tangible and intangible work product originated or developed by employees in connection with their employment, even if developed outside the Firm's premises. As a condition of your employment you agree that Cantor Fitzgerald shall have exclusive ownership of any and all right, title, and interest in (1) all copyright, trademarks, service mark rights, patents or processes associated with any work, mark, invention or process produced during the course of your employment which was originated or developed in connection with such employment; and (2) any such proprietary rights with respect to any invention or process originated or such proprietary rights with respect to any invention or process originated or developed in connection with your employment reduced to practice following the termination of your employment, if the invention or process existed in an intangible form prior to such termination, even if it was not workable at that time.

As further condition of your employment, you agree to execute any and all documents necessary to protect and preserve Cantor Fitzgerald's proprietary rights in copyrights, trademarks, service marks, patents, processes and trade secrets even if you are no longer employed by the Firm and including at Cantor Fitzgerald's request, you agree to confirm such assignment in writing. . . .